



PATENT
Attorney Docket No.: 056297-0001

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Ronald J. SAPOLSKY *et al.*)
)
Application No.: 10/696,452) Group Art Unit: Unassigned
)
Filed: October 29, 2002) Examiner: Unassigned
)
For: CAPTURING SEQUENCES ADJACENT)
TO TYPE-IIS RESTRICTION SITES FOR)
GENOMIC LIBRARY MAPPING)

Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

TRANSMITTAL FORM

1. Transmitted herewith is:

- ☒ Information Disclosure Statement
☒ Form PTO-1449, with 119 references included.

2. Extension of Time

The proceedings herein are for a patent application and the provisions of
37 C.F.R. § 1.136(a) apply.

- ☒ Applicant believes that no extension of time is required. However, this
conditional petition is being made to provide for the possibility that applicant has
inadvertently overlooked the need for a petition and fee for extension of time.

- ☐ Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a), for the total number of months checked below:

<u>Total Months Requested</u>	<u>Fee for Extension</u>	<u>[Fee for Small Entity]</u>
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 420.00	\$ 210.00
<input type="checkbox"/> three months	\$ 950.00	\$ 475.00
<input type="checkbox"/> four months	\$ 1,480.00	\$ 740.00

Extension of time fee due with this request: \$

If an additional extension of time is required, please consider this a Petition therefor.

- ☐ An extension for _____ months has already been secured and the fee paid therefor of \$_____ is deducted from the total fee due for the total months of extension now requested.

3. Constructive Petition

- ☒ EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

4. Fee Calculation (37 C.F.R. §1.16)

No fee is believed to be due at this time.

5. Fee Payment

- ☐ No fee is to be paid at this time.
- ☐ Check in the amount of \$_____ for _____. The Commissioner is hereby authorized to charge any additional extension of time fee or additional fee for claims due to Deposit Account No. 50-0310.

Appln. No. 10/696,452
Atty. Dkt. No. 056297-0001

☒ The Commissioner is hereby authorized to charge any additional fees which may be required, including fees due under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: November 20, 2003

By: Bonnie Weiss McLeod
Bonnie Weiss McLeod
Reg. No. 43,255

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PATENT
Attorney Docket No.: 056297-0001

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Ronald J. SAPOLSKY <i>et al.</i>)	
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GENOMIC LIBRARY MAPPING)	

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. § 1.97(b)**

Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Dear Sir:

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicants bring to the attention of the Examiner the documents listed on the attached PTO-1449. This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits for the above-referenced application.

Copies of the listed documents are attached. Applicants respectfully request that the Examiner consider the listed documents and evidence that consideration by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If it should be determined that any of the listed documents

do constitute "prior art" under United States law, Applicants reserve the right to present to the office the relevant facts and law regarding the appropriate status of such document.

Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

Except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP



Bonnie Weiss McLeod
Reg. No. 43,255

Dated: November 20, 2003

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**INFORMATION DISCLOSURE STATEMENT
BY APPLICANT**

Dkt. No.

056297-0001

1079.1E

Applicant: SAPOLSKY ET AL

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Examiner: Unassigned

Group Art Unit: Unassigned

U.S. PATENT DOCUMENTS

Examiner's Initials*		Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
	AR	6,472,185	10/2002	McCasky Feazel et al.	435	91.2	
	BR	6,100,030	08/2000	McCasky Feazel et al.	435	6	
	CR	6,103,463	08/2000	Chetverin et al	435	6	
	DR	5,700,637	12/1997	Southern	435	6	
	ER	6,027,889	02/2000	Barany et al.	435	5	
	FR	5,869,252	02/1999	Bouma et al.	435	6	
	GR	5,436,142	07/1995	Wigler et al.	435	91.2	
	HR	5,849,483	12/1998	Shuber	435	5	
	IR	5,589,330	12/1996	Shuber	435	5	
	JR	5,633,134	05/1997	Shuber	435	6	
	KR	5,508,178	04/1996	Rose et al.	435	91.1	
	LR	6,124,090	09/2000	Rose et al.	435	5	
	MR	6,107,023	08/2000	Reyes et al.	435	6	

FOREIGN PATENT DOCUMENTS

		Document Number	Date MM/YYYY	Country	Inventor Name		English Abstract		Translation Readily Available	
							Enclosed	No	Enclose	No
	NR	WO 89/12695	12/1989	PCT	Reyes et al.	C12Q	X			
	OR	WO 89/10414	11/1989	PCT	Wallace et al.	C12Q	X			
	PR	WO 93/06239	04/1993	PCT	Zabeau et al.	C12Q	X			
	QR	WO 96/03529	02/1996	PCT	Shuber	C12Q	X			
	RR	WO 90/08821	08/1990	PCT	Johnson	C12N	X			
	SR	0 379 369	07/1990	Europe	Rose et al	C12Q	X			
	TR	0 327 429 B1	08/1989	Europe	Keith et al	C12Q	X			

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

	UR	Kim et al, Journal of Cellular Biochemistry, Supplement 13E, Abstract W7160 (1989)	X			
	VR	Hacia et al., Nature Genetics, 14:441-447 (December, 1996)	X			
	WR	Cronin et al., Human Mutation, 7:244-255 (1996)	X			
	XR	Kozal et al., Nature Medicine, 2(7):753-59 (July, 1996)	X			
	YR	Vos et al., Nucleic Acids Research, 23(21):4407-4414 (1995)	X			

Examiner

Date Considered:

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



Dkt. No.		
	056297-0001	1079.1E

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Applicant: SAPOLSKY ET AL

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Examiner: Unassigned Group Art Unit: Unassigned

U.S. PATENT DOCUMENTS

Examiner's Initials*		Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
	AR	5,565,340	10/1996	Chenchik et al.	435	91.2	
	BR	5,093,245	03/1992	Keith et al.	435	91	
	CR	5,595,891	01/1997	Rose et al.	435	91.5	
	DR	6,294,323	09/2001	Ullman et al.	435	6	
	ER	5,366,877	11/1994	Keith	435	91.2	
	FR	6,258,539	07/2001	Hunkapiller et al.	435	6	
	GR	5,853,991	12/1998	Wang et al.	435	6	
	HR	6,174,709	01/2001	Kenten et al.	435	91.2	
	IR	5,413,909	05/1995	Bassam et al.	435	6	
	JR	5,599,696	02/1997	Mueller et al.	435	91.2	
	KR	5,501,964	03/1996	Wigler et al.	435	91.2	
	LR	5,512,458	04/1996	Leonard	435	91.1	
	MR	6,045,994	04/2000	Zabeau et al.	435	6	
	NR	6,277,606	08/2001	Wigler et al.	435	91.2	

FOREIGN PATENT DOCUMENTS

		Document Number	Date MM/YYYY	Country	Inventor Name		English Abstract		Translation Readily Available	
							Enclosed	No	Enclose	No
	OR	WO 94/11383	05/1994	PCT	Wigler et al.	C07H	X			
	PR	WO 93/12245	06/1993	PCT	Kenten et al.	C12P	X			
	QR	WO 90/10064	09/1990	PCT	Miller	C12N	X			
	RR	WO 91/05861	05/1991	PCT	Lovett et al.	C12N	X			
	SR	WO 90/09457	08/1990	PCT	Pasek	C12Q	X			
	TR									
	UR									
	VR									

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

	WR	Lew, Current Opinion in Immunology, 3:242-246 (1991)	X			
	XR	Roux et al., BioTechniques, 8(1):48-57 and Erratum, 8(3):265 (1990)	X			
	YR	Kawasaki et al., Methods in Enzymology, 218:369-81	X			
	ZR	Bugawan et al., The Journal of Immunology, 141(12):4024-4030 (December 1, 1988)	X			
	AAR	Bugawan et al., Am. J. Hum. Genet., 54:331-340 (1994)	X			

Examiner _____ Date Considered: _____

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.



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Examiner: Unassigned

Group Art Unit: Unassigned

U.S. PATENT DOCUMENTS

Examiner's Initials*		Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
	AR	5,597,694	01/1997	Munroe et al.	435	6	
	BR	5,470,724	11/1995	Ahern	435	91.2	
	CR	6,017,701	01/2000	Sorge et al.	435	6	
	DR	5,104,792	04/1992	Silver et al.	435	6	
	ER	6,218,119	04/2001	Kuiper et al.	435	6	
	FR	5,874,215	02/1999	Kuiper et al.	435	6	
	GR	6,159,713	12/2000	Wigler et al.	435	91.2	
	HR	5,876,929	03/1999	Wigler et al.	435	6	
	IR	5,814,444	09/1998	Rabinovitch	435	6	
	JR	5,693,464	12/1997	Trent et al.	435	6	
	KR	6,258,533	07/2001	Jones	435	6	
	LR	6,060,245	05/2000	Sorge et al.	435	6	
	MR	6,261,782	07/2001	Lizardi et al.	435	6	

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	NR								
	OR								
	PR								

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

	QR	Krausa et al., Human Immunology, 44:35-42 (1995)	X			
	RR	Gonzalez-Escribano et al., Annals of the Rheumatic Diseases, 54:386-388 (1995)	X			
	SR	Hashimoto et al., Tissue Antigens, 44:166-173 (1994)	X			
	TR	Ratanachaiyavong et al., European Journal of Clinical Investigation, 24:309-315 (1994)	X			
	UR	Caetano-Anolles et al., Mol. Gen. Genet., 235:157-165 (1992)	X			
	VR	Akowitz et al., Gene, 81:295-306 (1989)	X			

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Examiner's Initials*		Document Number	Date MM/YYYY	Name (Family Name of First Inventor)	Class	Sub Class	Filing Date (if appropriate)
	AR	6,270,966	08/2001	Weinstein et al.	435	6	
	BR	5,789,206	08/1998	Tavtigian et al.	435	91.2	
	CR	5,994,068	11/1999	Guilfoyle et al.	435	6	
	DR	6,280,948	08/2001	Guilfoyle et al.	435	6	
	ER	5,707,807	01/1998	Kato	435	6	
	FR	5,824,481	10/1998	Kambara et al.	435	6	
	GR	5,814,445	09/1998	Belyavsky et al.	435	6	
	HR	6,120,996	09/2000	Belyavsky et al.	435	6	
	IR	5,712,126	01/1998	Weissman et al.	435	91.2	
	JR	6,010,850	01/2000	Weissman et al.	435	6	
	KR	6,287,825	09/2001	Weissman et al.	435	91.2	
	LR	5,252,724	10/1993	Kishimoto et al.	435	91.52	
	MR	5,858,656	01/1999	Deugan et al.	435	6	

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	OR									
	PR									

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

	QR	Saunders et al., Nucleic Acids Research, 17(22):9027-9037 (1989)	X			
	RR	Lüdecke et al., Hum. Genet., 84:512-516 (1990)	X			
	SR	Chang et al., Genomics, 12:307-312 (1992)	X			
	TR	Launer et al., M.M. Shemyakin and Yu A. Ovchinnikov Institute of Bioorganic Chemistry, Russian Academy of Sciences, Moscow (Nov.-Dec., 1994)	X			
	UR	Ren et al., BioTechniques, 22:36-40 (January, 1997)	X			
	VR	Loukianov et al., BioTechniques, 15(6):980-982 (1993)	X			
	WR	Qureshi et al., GATA, 11(4):95-101 (1994)	X			
	XR	Kalman et al., Biochemical and Biophysical Research Communications, 167(2):504-506 (1990)	X			
	YR	Rosenthal et al., Nucleic Acids Research, 18(10):3095-3096 (1990)	X			
	ZR	Scully et al., Molecular and Cellular Probes, 4:485-495 (1990)	X			

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Group Art Unit: Unassigned

U.S. PATENT DOCUMENTS

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	AR 6,221,600	04/2001	MacLeod et al.	435	6	
	BR 6,114,149	09/2000	Fry et al.	435	91.2	
	CR 5,427,932	06/1995	Weier et al.	435	91.2	
	DR 6,322,971	11/2001	Chetverin et al	435	6	
	ER					

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					Enclosed	No	Enclose	No
	FR							
	GR							
	HR							

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

IR	Patel et al., Nucleic Acids Research, 19(16):4371-4375 (1991)	X		
JR	Jones et al., BioTechniques, 23:132-138 (July, 1997)	X		
KR	Shagin et al., Nucleic Acids Research, 27(18):e23 (1999)	X		
LR	Carbonari et al., Trends in Genetics, "Optimization of PCR performance", 9(2):42-43 (February, 1993)	X		
MR	Erlich et al., Annu. Rev. Genet., 26:479-506 (1992)	X		
NR	Luo et al., Journal of Clinical Laboratory Analysis, 13:69-74 (1999)	X		
OR	Nadeau et al., Mammalian Genome, 3:55-64 (1992)	X		
PR	Agostini et al., Journal of NeuroVirology, 1:316-320 (1995)	X		
QR	Bell, Immunology Today, 10(10):351-355 (1989)	X		
RR	Bej et al., Critical Reviews in Biochemistry and Molecular Biology, 26(3/4):301-334 (1991)	X		
SR	Given et al., Journal of Virology, 30(3):852-862 (June, 1979)	X		
TR	Roux, PCR Methods and Applications, 4(5):S185-S194 (April, 1995)	X		
UR	Ohler et al., PCR Methods and Applications, 2(1):51-59 (April, 1992)	X		
VR	Williams, BioTechniques, 7(7):762-769 (July/August, 1989)	X		
WR	Xu et al., Comp. Immun. Microbiol. Infect. Dis., 14(3):209-221 (1991)	X		
XR	Lagerström et al., PCR Methods and Applications, 1:111-119 (1991)	X		
YR	Reyes et al., Molecular and Cellular Probes, 5:473-481 (1991)	X		

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	CR					

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	DR							
	ER							
	FR							

OTHER (Including in this order Author, Title, Periodical Name, Date, Pertinent Pages, etc.)

GR	Gibbs, Anal. Chem., 62:1202-1214 (1990)	X			
HR	Lüdecke et al., Nature, 338:348-350 (March 23, 1989)	X			
IR	Siebert et al., Nucleic Acids Research, 23(6):1087-1088 (1995)	X			
JR	Mullis, PCR Methods and Applications, 1(1):1-4 (August, 1991)	X			
KR	Jones et al., BioTechniques, 15(5):894-902 (1993)	X			
LR	Kandpal et al., Proc. Natl. Acad. Sci. USA, 91:88-92 (January, 1994)	X			
MR	Kainz et al, Analytical Biochemistry 202:46-49 (1992)	X			
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